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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ZD, Inc.

Serial No. 75/029,345

Karen L. Fiesthamel of Kenyon & Kenyon for ZD, Inc.

David H. Stine, Trademark Examining Attorney, Law Office
114 (Mary Frances Bruce, Managing Attorney).

Before Cissel, Walters and McLeod, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 7, 1995, applicant filed an application to register the mark "CORPORATE WEB" on the Principal Register for what were subsequently identified by amendment as "magazines, newspapers, newsletters and journals, and supplements thereto and sections thereof[,] about the use of computer information networks and computer networks by large organizations for internal communication purposes and marketing purposes," in Class 16. The basis for the

application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these goods.

Registration was refused under Section 2(e)(1) of the Lanham Act on the ground that the mark applicant seeks to register is merely descriptive of the publications specified in the application. Applicant responded to the refusal to register with argument that the mark is not descriptive of the listed publications within the meaning of the statute, but rather would be only suggestive if used in connection with these goods.

The Examining Attorney was not persuaded by applicant's arguments, and the refusal to register was made final. Applicant filed a timely Notice of Appeal along with a request for reconsideration, attached to which was a copy of a dictionary definition of the word "web" as, inter alia, "an intricate structure suggestive of something woven: NETWORK." Applicant argued that when using "web" in combination with the word "corporate," the resulting combination connotes the intricate layers and levels of hierarchy, including communication paths, associated with a big business, and as such, that the mark would impart to the purchaser of applicant's publications a suggestion as

to the subject of the goods without directly identifying the subject matter with any specificity.

The Board instituted the appeal, but suspended action on it and remanded the application for reconsideration by the Examining Attorney. Responsive to the reconsideration request, the Examining Attorney maintained the refusal to register. Attached to his Office Action were copies of excerpts from forty-eight stories retrieved from the Nexis® database. The Examining Attorney argued that the term sought to be registered appeared in over a thousand stories, and that the excerpts attached to his Office Action represent only the first group of these. Noting that the Trademark Trial Appeal Board and courts have consistently held that marks which describe the subject matter of publications are merely descriptive, and hence unregistrable under Section 2(e)(1) of the Lanham Act, he concluded that "... it is considered to be beyond obvious that applicant's publications are [will be] focused on the subject of the 'corporate web.'"

Action on the appeal was then resumed. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing before the Board. Accordingly, we have resolve this appeal based on the written record and arguments presented.

There does not appear to be any serious disagreement between the applicant and the Examining Attorney with regard to the test for mere descriptiveness under Section 2(e)(1) of the Act. The mark is merely descriptive of product if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). See also: *In re Abcor Development Corp.*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). In order to be descriptive, the mark must immediately convey this information about the ingredients, qualities or characteristics of the goods with "a degree of particularity." *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199 (TTAB 1981); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 549, 952 (TTAB 1981); *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978); and *In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986). If, however, when the goods or services are encountered under the mark in question, a multistage reasoning process or imagination is required in order to determine the attributes or characteristics of the product, the mark is suggestive, rather than merely descriptive.

A number of decisions support the proposition that a term which names the subject matter of a publication is

merely descriptive of that publication. In re Medical Digest, Inc., 148 USPQ 570 (TTAB 1965); In re World Library Publications, Inc., 198 USPQ 442 (TTAB 1978); Yankee, Inc. v. Geiger, 216 USPQ 996 (TTAB 1982); In re Kalmbach Publishing Co., 14 USPQ2d 1490 (TTAB 1989).

Moreover, the burden is on the Examining Attorney to establish that term for which registration is sought is merely descriptive within the meaning of the Lanham Act. In re Merrill Lynch, Pierce, Fenner, and Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). If there exists any doubt as to whether the term falls within the proscription of Section 2(e)(1), that doubt must necessarily be resolved in favor of the applicant. In re Gormet Bakers, 173 USPQ 565 (TTAB 1972); In re Atavio, 25 USPQ2d 1361,1362 (TTAB 1992).

In the case now before the Board, we hold that the Examining Attorney has not met his burden of establishing the descriptiveness of "CORPORATE WEB" in connection with the publications specified in this application.

As noted above, the only support in for the refusal to register was provided after the refusal had been made final, in response to applicant's request for reconsideration. It is the position of the Examining Attorney that the excerpts of record "clearly illustrate

that the terminology 'corporate web site,' often truncated to 'corporate web,' is in common generic usage to refer to computer information networks and web sites on such networks which are used for communication internally, within the corporate structure, and externally, with potential purchasers and the public." (Office Action of November 10, 1998). He states that "applicant's publications are clearly directed to, inter alia, the use of the 'corporate web' or corporate web sites." (brief, p.3). His position appears to be predicated on his assertion that the term sought to the registered, "CORPORATE WEB," is synonymous with "corporate web site" or is used to refer to corporate information networks.

The problem is that the evidence of record does not demonstrate that "corporate web" and "corporate web site" refer to the same thing, or that "corporate web" is used in reference to corporate information networks. Within the four dozen brief excerpts, the terms "corporate web site" or "corporate web sites" appear a hundred nineteen times, but there are only a handful of examples of the use of the term "corporate web," and none of these clearly establishes that the term is used in reference to corporate information networks or that it is synonymous with "corporate web site." When we disregard the articles from newswires and

from foreign news sources, (as we must, because these excerpts are not evidence of usages to which the purchasing public in the United States has necessarily been exposed,) we are not left with anything that clearly demonstrates that the term sought to be registered has the meaning argued by the Examining Attorney.

Moreover, even if we were to consider all the excerpts submitted in support of the refusal to register, we could conclude only that the term "corporate web" is used to refer to either the infrastructure of a corporation or to the general field of electronic commerce which is conducted by means of the Internet. These connotations are not definite enough to satisfy the descriptiveness test's requirement for specificity or particularity.

In summary, it is not at all clear from the evidence submitted by the Examining Attorney that the term sought to be registered is a "truncated" form of "corporate web site" or that it identifies, with any specificity, a feature, characteristic or subject of the magazines and other publications with which applicant intends to use it. As noted above, any doubts with which we are left in the

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resolution of the issue of descriptiveness are to be resolved in favor of the applicant. Accordingly, the refusal to register is reversed.

R. F. Cissel

C. E. Walters

L. K. McLeod
Administrative Trademark Judges
Trademark Trial & Appeal Board

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